

PTO Form 1857 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78839916
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Office Action, the Examining Attorney requested that Applicant disclaim the composite phrase "DETROIT CHOPPERS". Applicant, however, respectfully traverses the requirement that the application be amended to include a disclaimer of the entire composite phrase.</p> <p>While a disclaimer of the individual component words of a complete descriptive phrase may be improper, [t]he issue is whether the components form a grammatically or otherwise unitary expression, not whether they are contiguous." <i>See In re Grass GmbH</i>, 79 U.S.P.Q.2d 1600, 1603 (TTAB 2006). In <i>Grass</i>, the TTAB determined that components of the phrase SNAP ON 3000 could be separately disclaimed as SNAP ON and 3000 since the two components were descriptive, but for different reasons. Specifically, the Board stated that "although the components in question are contiguous in the mark, they are not a unitary expression because each component retains its separate descriptive significance..." Since the composite phrase used the present application is similar to that discussed in <i>Grass</i>, Applicant too should be permitted to separately disclaim only the DETROIT, or at worst the term DETROIT separate from the term CHOPPERS.</p> <p>Applicant notes that it is also the owner of U.S. App. Serial No. 76477001, which is directed to an almost identical mark and goods. However, in the '001 application the Examining Attorney merely required a disclaimer of the term DETROIT. This limiting of the disclaimer to only the term DETROIT is a clear acknowledgement by the Trademark Office that the composite phrase DETROIT CHOPPERS (as used in the instant mark) is not a unitary term that must be completely disclaimed.</p> <p>Further, as was the case in <i>Grass</i>, while DETROIT and CHOPPERS may be individually descriptive (see attachments A and B), each component has retained its separate descriptive significance. To support this conclusion, Applicant again points to the limited disclaimer of the '001 application and the clear descriptive differences between the two terms. As such, there is no grammatical connection or other nexus between those terms <u>mandating</u> their disclaimer was a unitary phrase. The Examining Attorney is also kindly referred to U.S. Reg. No. 2276438 (Detroit North American International Auto Show); 2553547 (Detroit Zoo); 2607444 (The Detroit Cigar Extravaganza); 3106328 (Detroit Bros); and 3123401 (Detroit Science Center). In each of these registrations, the disclaimer was limited to the term Detroit alone, or the term Detroit alone plus an additional disclaimer of another term(s).</p> <p>Finally, as was also the case in <i>Grass</i>, Applicant points out that a separate disclaimer of DETROIT and CHOPPERS would allow competitors to use each of those term individually. However, competitors have no need to use the composite DETROIT CHOPPERS.</p>	

Therefore, Applicant requests reconsideration of the requirement to disclaim the entire composite phrase DETROIT CHOPPERS.
Applicant has also timely filed a Notice of Appeal with the Trademark Trials and Appeal Board.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	\\TICRS2\EXPORT13\788\399\78839916\xml1 \ROA0002.JPG
	\\TICRS2\EXPORT13\788\399\78839916\xml1 \ROA0003.JPG
DESCRIPTION OF EVIDENCE FILE	Attachment A & B - Scanned copies of Merriam-Webster online for Detroit and Chopper

ADDITIONAL STATEMENTS SECTION

MISCELLANEOUS STATEMENT	Such action is respectfully requested. The Commissioner is authorized to charge any fee in connection with this communication to our Deposit Account No. 07-1180. Attorney for Applicant may be contacted at (248) 647-6000 with any questions the Examining Attorney may have.
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SIGNATURE SECTION

DECLARATION SIGNATURE	/mds/
SIGNATORY'S NAME	Mark D. Schneider
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	06/27/2007
RESPONSE SIGNATURE	/mds/
SIGNATORY'S NAME	Mark D. Schneider
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	06/27/2007
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Wed Jun 27 15:59:04 EDT 2007
TEAS STAMP	USPTO/ROA-209.114.252.202 -20070627155904639946-788 39916-3707559cebe8eb64811 9f8de3e7a9223f8-N/A-N/A-2 0070627154510376224

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78839916** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

In the Office Action, the Examining Attorney requested that Applicant disclaim the composite phrase "DETROIT CHOPPERS". Applicant, however, respectfully traverses the requirement that the application be amended to include a disclaimer of the entire composite phrase.

While a disclaimer of the individual component words of a complete descriptive phrase may be improper, [t]he issue is whether the components form a grammatically or otherwise unitary expression, not whether they are contiguous." See *In re Grass GmbH*, 79 U.S.P.Q.2d 1600, 1603 (TTAB 2006). In *Grass*, the TTAB determined that components of the phrase SNAP ON 3000 could be separately disclaimed as SNAP ON and 3000 since the two components were descriptive, but for different reasons. Specifically, the Board stated that "although the components in question are contiguous in the mark, they are not a unitary expression because each component retains its separate descriptive significance..." Since the composite phrase used the present application is similar to that discussed in *Grass*, Applicant too should be permitted to separately disclaim only the DETROIT, or at worst the term DETROIT separate from the term CHOPPERS.

Applicant notes that it is also the owner of U.S. App. Serial No. 76477001, which is directed to an almost identical mark and goods. However, in the '001 application the Examining Attorney merely required a disclaimer of the term DETROIT. This limiting of the disclaimer to only the term DETROIT is a clear acknowledgement by the Trademark Office that the composite phrase DETROIT CHOPPERS (as used in the instant mark) is not a unitary term that must be completely disclaimed.

Further, as was the case in *Grass*, while DETROIT and CHOPPERS may be individually descriptive (see attachments A and B), each component has retained its separate descriptive significance. To support this conclusion, Applicant again points to the limited disclaimer of the '001 application and the clear descriptive differences between the two terms. As such, there is no grammatical connection or other nexus between those terms mandating their disclaimer was a unitary phrase. The Examining Attorney is also kindly referred to U.S. Reg. No. 2276438 (Detroit North American International Auto Show); 2553547 (Detroit Zoo); 2607444 (The Detroit Cigar Extravaganza); 3106328 (Detroit Bros); and 3123401 (Detroit Science Center). In each of these registrations, the disclaimer was limited to the term Detroit alone, or the term Detroit alone plus an additional disclaimer of another term(s).

Finally, as was also the case in *Grass*, Applicant points out that a separate disclaimer of DETROIT and CHOPPERS would allow competitors to use each of those term individually. However, competitors have no need to use the composite DETROIT CHOPPERS.

Therefore, Applicant requests reconsideration of the requirement to disclaim the entire composite phrase DETROIT CHOPPERS.

Applicant has also timely filed a Notice of Appeal with the Trademark Trials and Appeal Board.

Evidence

Evidence in the nature of Attachment A & B - Scanned copies of Merriam-Webster online for Detroit and Chopper has been attached.

Evidence-1

Evidence-2**Additional Statements**

Such action is respectfully requested. The Commissioner is authorized to charge any fee in connection with this communication to our Deposit Account No. 07-1180. Attorney for Applicant may be contacted at (248) 647-6000 with any questions the Examining Attorney may have.

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /mds/ Date: 06/27/2007
Signatory's Name: Mark D. Schneider
Signatory's Position: Attorney for Applicant

Response Signature

Signature: /mds/ Date: 06/27/2007
Signatory's Name: Mark D. Schneider
Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 78839916
Internet Transmission Date: Wed Jun 27 15:59:04 EDT 2007

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Search

Detroit

2 entries found.

Detroit
Eastpointe

Main Entry: **De-troit** (d)
Pronunciation: /di-'troit, locally also 'dē-,
Function: *geographical name*

- river 31 miles (50 kilometers) Ontario & SE Michigan connecting Lake Erie & Lake Saint Clair
 - city SE Michigan on Detroit River population 951,270
- **De-troit-er** (d) /di-'trōi-tər/ *noun*

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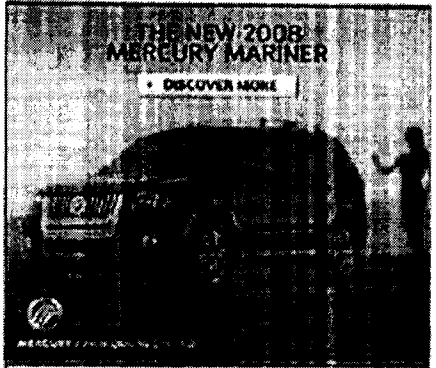
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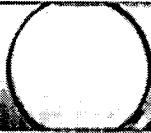


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chopper

2 entries found.

chopper [1.noun]
chopper [2.verb]

Main Entry: **1 chop- per** **4**
Pronunciation: /chə- pər/
Function: *noun*
Date: 1552

- 1 : one that chops
- 2 *plural slang* : 100.00
- 3 : a device that interrupts an electric current or a beam of radiation (as light) at short regular intervals
- 4 : MACHINE GUN
- 5 : HELICOPTER
- 6 : a high-bouncing batted baseball
- 7 : a customized motorcycle

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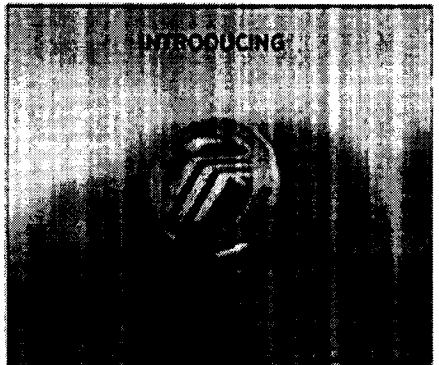
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